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EXAMINER

TUCKER, PHILIP C

ART UNIT

PAPER NUMBER

1712

DATE MAILED: 11/06/2002

3

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

905358

Applicant(s)

HARRIS

Examiner

P. TUCKER

Group Art Unit

1712

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- ☐ Responsive to communication(s) filed on \_\_\_\_\_
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1 - 81 is/are pending in the application.  
Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1 - 4, 10 - 12, 16 - 20, 22 - 81 is/are rejected.
- ☒ Claim(s) 5 - 9, 13 - 15, 21 is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement

## Application Papers

- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some\* ☐ None of the:
  - ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_
  - ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 2 ☐ Interview Summary, PTO-413
- ☒ Notice of Reference(s) Cited, PTO-892 ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948 ☐ Other \_\_\_\_\_

Office Action Summary

Art Unit: 1712

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 20, 22-24, 28-81 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 20, 47 and 76 teach “highly substituted guar” without teaching the meaning or scope of “highly”, and are thus indefinite.

Claims 22-24, 49-51, 78-80 contains the trademark/trade names such as Dimehypo, Acephate, vamidothion, methomyl, dalapon, dicamba, fomesafen, glyphosate, fosetyl-Al, benalaxyl, guazatine and kasugamycin. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present

Art Unit: 1712

case, the trademark/trade name is used to identify/describe pesticides, herbicides and fertilizers and, accordingly, the identification/description is indefinite.

Regarding claim 28, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPFP § 2173.05(d). Dependent claims fall herewith.

In claim 55, the term "develops desired suspension properties" appears, without a definition of the properties which are desired. The scope of the claim is thus uncertain.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 2, 4, 12, 16-19, 25-29, 31, 39, 43-46, 52-56, 58-60, 68, 72-75 and 81 are rejected under 35 U.S.C. 102(b) as being anticipated by Eriksson (3670065).

Eriksson teaches a composition comprising hydrogenated castor oil, polyalkylene glycol and particles within the scope of the present invention (see example 1).

Art Unit: 1712

5. Claims 1, 2, 12, 17-19, 25-29, 39, 44-46, 52-56, 58, 59, 68, 73-75 and 81 are rejected under 35 U.S.C. 102(b) as being anticipated by Goodhart (3780170).

Goodhart teaches a composition comprising hydrogenated castor oil, polyalkylene glycol and particles within the scope of the present invention (see example 4 and claim 1).

6. Claims 1-4, 12, 16, 25-31, 39, 43, 52-60, 68, 72 and 81 are rejected under 35 U.S.C. 102(b) as being anticipated by Schmitt (3629398).

Schmitt teaches a composition comprising hydrogenated castor oil, polyalkylene glycol and particles within the scope of the present invention (see example 1).

7. Claims 1, 2, 12, 25, 26, 28, 29, 39, 53, 55, 56, 59, 68, 81 are rejected under 35 U.S.C. 102(b) as being anticipated by Heafield (5879705).

Heafield teaches a composition comprising hydrogenated castor oil, polyalkylene glycol and particles within the scope of the present invention (see Table T).

8. Claims 1-4, 10, 11, 16-20, 25-31, 37, 38, 43-47, 52-60, 66, 67, 72-76 and 81 are rejected under 35 U.S.C. 102(b) as being anticipated by Thiele (5648421).

Thiele teaches a composition comprising castor oil, polyalkylene glycol and particles within the scope of the present invention (see example 2). Column 4, lines 64-66 teaches that the castor oil used is hydrogenated castor oil

Art Unit: 1712

***Double Patenting***

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. Claims 1-3, 12, 26-30, 39, 53-59 and 68 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-98 of

Art Unit: 1712


copending Application No. 09/771226. Although the conflicting claims are not identical, they are not patentably distinct from each other because although the present claims differ in not specifically stating that the particles are polymeric, they would comprise the same hydrogenated castor oil, polyalkylene glycol and particles when the particles are polymeric, and thus the present claims would be rendered obvious to one of ordinary skill in the art over the claims of 09/771226.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

11. Claims 5-9, 13-15 and 21 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip Tucker whose telephone number is (703) 308-0529. The examiner's normal working hours are 7:30am-4:00pm, Monday-Friday. If necessary SPE Robert Dawson may be contacted at 703-308-2340. For inquiries of a general nature call the receptionist at 703-308-0651. The group FAX no. is 703-872-9310. The **after final** fax no. Is 703-872-9311.

PCT-2671  
November 4, 2002

  
PHILIP C. TUCKER  
ART UNIT 1712